REMARKS

This Amendment is filed in response to the Final Office Action mailed May 14, 2008 (the "*Final Office Action*"). In this Amendment, claims 33 and 62 are amended, and claims 34, 51-53, 63, and 64 are unchanged. Claims 1-32, 35-50, and 54-61 were previously cancelled. Following entry of this amendment, claims 33, 34, 51-53, and 62-64 shall be pending.

In the *Final Office Action*, claims 33, 34, 51-53, and 62-64 are rejected based on prior art grounds. For the reasons set forth below, these rejections are hereby traversed.

I. CLAIM AMENDMENTS

The Applicants respectfully request entry of the above amendments. Claims 33 and 62 have been amended to correct a typographical error that was inadvertently presented in the claim amendments submitted in the Applicants' Amendment of February 6, 2008. These errors were first discovered during preparation of the present response. The present amendments do not present new matters for consideration and simply place certain elements of the claimed device in a proximal/distal orientation consistent with that disclosed in the specifications. *See* Present Application at ¶ [0188].

II. REJECTION UNDER 35 U.S.C. § 102

Claims 33, 34, 51, 53, and 62-64 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,540,707 to Ressemann et al. ("*Ressemann et al.*"). Claims 34, 51, 53, and 62-64 depend from independent claim 33. For at least the reasons set forth below, it is submitted that this prior art rejection should be withdrawn and the pending claims allowed.

As illustrated in FIGS. 13 and 14 and described at column 22, lines 48-57, *Ressemann et al.* teach that the proximal ends 202 of the wires 102 that form the removal element 16 are attached to the annular bearing member 204. The bearing

member 204 is, in turn, coupled to the complementary bearing member 206, and the bearing member 206 is attached to the distal end 208 of the catheter shaft 188. *Id.* Additionally, at column 23, line 62 through column 24, line 7, *Ressemann et al.* teach:

> Because the distal end 98 of the drive shaft 92 is fixed to the distal annulus 108 and the removal element 16, ***distal axial movement of the catheter shaft 188 with respect to the drive shaft 92 reduces the axial distance between the distal annulus 108 and the bearing members 204 and 206***. The bearing member 206 transmits force from the catheter shaft 188 to the bearing member 204, and, from there, to the wires 102. Opposite ends of the braided wires 102 are attached to the distal annulus 108 and the bearing member 204, respectively, such that reduction of the axial distance between the distal annulus 108 and the bearing member 204 causes the wires 102 to bow radially outwardly from the inner coil 94 of the drive shaft 92.

(emphasis added).

Ressemann et al. cannot be properly relied upon as anticipating the invention as claimed for at least three reasons. First, in the *Final Office Action*, the Examiner asserts that *Ressemann et al.* teach "an embolus removal apparatus 16 disposed on an inner tube 94 which is housed within an outer tube 188." At page 2 ¶ 3. Based on the above provided teachings of *Ressemann et al.*, it is evident that the Examiner's assertion is incorrect. The proximal end of the removal element 16 is attached to the distal end of catheter shaft 188. At FIGS. 13 and 14 and column 22, lines 48-57. Therefore, one of ordinary skill in the art would recognize that the only way in which removal element 16 could be housed within the outer tube 188, to which it is attached, is if removal element 16, in some manner, folded on to itself underneath catheter shaft 188 by a distal axial movement of catheter shaft 188. Yet, as also apparent from the above cited passage, a distal axial movement of the catheter shaft 188 with respect to the drive shaft 92 causes the removal element 16 to bow radially outwardly—not fold on to itself. At column 23,

line 62 through column 24, line 7. Accordingly, *Ressemann et al.* fail to teach that the removal element 16 is housed within an outer tube 188.

Second, *Ressemann et al.* fail to teach an embolus removal apparatus wherein the outer tube is axially retractable to remove the constraint on the embolus removal apparatus such that the embolus removal apparatus automatically expands from said collapsed configuration to a deployed configuration upon said axial retraction of said outer tube, as recited in amended claim 33. Not only is the removal element 16 of *Ressemann et al.* ***not*** constrained by a portion of the catheter shaft 188, as discussed above, but the removal element 16 is also inoperable to expand upon an axial retraction of catheter shaft 188. As taught by *Ressemann et al.*, an axial retraction of catheter 188 would cause the distance between the distal and proximal ends of removal element 16 to lengthen, thereby resulting in a ***contraction*** of removal element 16—not an expansion. At column 23, line 62 through column 24, line 7.

Finally, *Ressemann et al.* fail to teach an embolus removal apparatus comprising a plurality of resilient members having proximal ends freely slidable over said inner tube, as recited in amended claim 33. To the contrary, *Ressemann et al.* teach that the proximal ends 202 of braided wires 102 are attached to bearing member 204. At FIGS. 13 and 14 and column 22, lines 48-57. Bearing member 204 is, in turn, coupled to the complementary bearing member 206, which is attached to the distal end 208 of the catheter shaft 188. *Id.*

While the proximal ends 202 of the removal element 16 may be slidable over the inner coil 94 of *Ressemann et al.*, due to the fact that the proximal ends 202 are attached to the distal end 208 of the catheter shaft 188, one of ordinary skill in the art would understand that the proximal ends 202 are not "freely slidable." Any sliding of the proximal ends 202 of the removal element 16 relative to inner coil 94 would inherently not be of the removal element's 16 own accord but rather dictated by sliding or otherwise transposing the catheter shaft 188.

Similarly, *Ressemann et al.* fail to teach an embolus removal apparatus that automatically expands from a collapsed configuration, as recited in amended claim 33. As described above, expansion of removal element 16 results from the controlled distal axial movement of catheter shaft 188. An apparatus that expands only through a controlled movement directed upon it can hardly be considered to be operable to automatically expand.

Considering the above, it is evident that *Ressemann et al.* fail to anticipate the Applicants' claimed invention. Hence, for at least the above reasons, it is submitted that claim 33 is novel over the cited prior art.

Turning to claims 34, 51, 53, and 62-64, these claims depend from claim 33 and thus for at least the same reasons as provided above, these claims are also novel over the cited prior art. However, these claims further limit the claimed invention and thus are separately patentable over the cited prior art.

III. REJECTION UNDER 35 U.S.C. § 103

Claim 52 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ressemann et al.* in view of U.S. Patent No. 5,167,239 to Cohen et al. ("*Cohen et al.*"). For at least the reasons set forth below, it is submitted that this prior art rejection should be withdrawn and the pending claim allowed.

In the *Final Office Action*, the Examiner asserts that *Ressemann et al.* disclose or make obvious the invention as claimed with the exception of the plurality of infusion ports located near said embolus removal apparatus recited in claim 52. The Examiner is referred to the previously presented arguments in this Amendment with regard to claim 33, from which this claim depends. For at least the same reasons provided above, *Ressemann et al.* fail to teach or make obvious the invention of claim 52.

Furthermore, *Cohen et al.* fail to make up for the deficiencies of *Ressemann et al. Cohen et al.* are directed towards an anchorable guidewire comprising an elongated guidewire body, an inner tube, and at least one inflatable anchoring balloon. At column

5, lines 13-26. *Cohen et al.* fail to disclose or make obvious an embolus removal apparatus, constraint of such an apparatus by an outer tube, or the configuration and automatic expansion of such an apparatus. Accordingly, at least for these reasons, it is submitted that this prior art rejection should be withdrawn and the pending claim 52 allowed. However, this claim further limits the claimed invention and thus is separately patentable over the cited prior art.

CONCLUSION

In view of the foregoing, it is submitted that pending claims 33, 34, 51-53, and 62-64 are now in condition for allowance. Hence an indication of allowability is hereby requested.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any additional fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: August 13, 2008

Shane S. Swanson
Registration No. 52,263

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.
Inskeep Intellectual Property Group, Inc.
2281 W. 190th Street, Suite 200
Torrance, CA 90504
Phone: 310-755-7800
Fax: 310-327-3466

Customer No. 37,374